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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,375	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.745	5136
25883	7590	12/02/2005	EXAMINER	
HOWISON & ARNOTT, L.L.P. P.O. BOX 741715 DALLAS, TX 75374-1715			NGUYEN, HAI V	
			ART UNIT	PAPER NUMBER
			2142	
DATE MAILED: 12/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/382,375	Applicant(s) PHILYAW ET AL.	
	Examiner Hai V. Nguyen	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the communication received on 16 November 2005.
2. Claims 1-6, 8-17 are presented for examination.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 November 2005 has been entered.

Specification

4. The textual portion of the specification is replete with grammatical and idiomatic errors too numerous to mention specifically. The specification should be revised carefully.
5. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors

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could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 12, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claims, 1 12, 13, the phrase in the preamble which recites "the machine readable product code having encoded product code information contained therein and the purpose thereof not routing to the desired location on the network, the product code information having no routing information embedded therein which would allow the product code information," renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

9. Claims 1, 12, 13 recite the limitation "reading the machine readable code at a user location on the network" in claims 1, 12, 13. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-6, 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hudetz et al.** US patent no. **6,199,048 B1** in view of **Call** US patent no. **5,913,210** and further in view of **Tracy et al.** U.S patent #: **5,979,757**.

12. As to claim 1, Hudetz, System And Method For Automatic Access Of Remote Computer Over A Network, discloses a method for providing an interconnection relationship between a product that has disposed thereon a machine readable product code on the product, and a desired location (*a desired resource*) on a global communications network (*Fig. 1, internet 20*), the machine readable product code having encoded product code information contained therein and the purpose not routing to the desired location on the network, the product code information having no routing information embedded therein which would allow the product code information, in or of itself, to cause routing to the desired location over any path on the network, comprising the steps of

reading the machine-readable code at a user location on the network (*Hudetz, col. 10, lines 58-67; col. 11, lines 1-67; col. 12, lines 1-23*);

in response to the step of reading the machine readable product code, and without user intervention, of a user at the user location on the network, extracting the product code information from the machine readable product code (*Hudetz, col. 9, line 55 - col. 12, line 23*); However, Hudetz does not explicitly disclose assembling a message packet containing the product code information.

In the same field of endeavor, Call, a related Methods And Apparatus For Disseminating Product Information Via The Internet, discloses in the internetworking art, *"Thus, information uniquely formatted to best advantage by the manufacturer could be made available by accessing a single URL, having the same form for all products, formed by combining the IP-address obtained from the standard by concatenating a prefix and suffix. The suffix has the form: "upcinfo/1234567890 1234/info.html" where the numerical part is the universal product code directory name, and where the suffix is appended to the at the end of the prefix of the form: "http://123/123/40/198" consisting of protocol identifier "http://" and by the 32-bit IP address from the product code translator written in its standard four decimal number format (four three digit numbers separated by periods, each of which is a value in the range 0-255 representing the binary value of one of the four 8-bit bytes making up the 32-bit IP address) (Call, col. 8, line 66 – col. 9, line 19).*

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Call's teachings of the concatenating a message containing the product code information (*Call, col. 8, line 66 – col. 9, line 19*) with the teachings of Hudetz, for the purpose of *providing limited product*

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description information for each product offered to enable more efficient indexing, cataloging, inventory control, and other applications (Call, col. 10, lines 1-5).

Call discloses transmitting the message packet to an intermediate code on the network having associated therewith a database which has stored therein relationships between the product code information and routing information for at least one desired location on the network *(Call, the Product Code Translator as an Internet Resource, storing cross-references between universal product codes identifying specific products, and Internet addresses specifying the locations at which information about these products may be obtained (Call, col. 1, line 32 – col. 2, line 4; col. 2, lines 33-60).*

However, Hudetz-Call does not explicitly disclose in accordance with the stored relationships in the database, converting the received product code information to routing information over the network to the at least one desired location associated therewith in the database, which routing information, associated with an instructional code, is returned to the user location and defines the manner by which a user or a computer at a user location wherein the machine readable code was read can communicate with the at least one desired location via an interconnection therewith.

In the same field of endeavor, Tracy, a related Method And System For Presenting Item Information Using A Portable Data Terminal, discloses in the internetworking art, that, *"In a preferred embodiment of the present invention, a portable terminal having an integrated machine code reader and a radio is provided with a graphical user interface such as a "web browser." The terminal is provided with a display for illustrating help and instructional files associated with a selected item*

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identified with the machine code reader. Thus, a warehouse clerk who reads a bar code from a box of potato chips will automatically retrieve from the central host an instruction file instructing the person where to forward the package, or in an alternative embodiment, an airplane mechanic will be provided with repair instructions from a central host for an engine part which is marked with a machine readable code. In an alternative embodiment, a consumer using a hand-held terminal in a self-scanning application of the present invention (sometimes referred to as self-shopping or self-checkout) receives marketing, pricing, and additional information from a central host for products she has scanned with her portable terminal, col. 2, lines 12-62; col. 5, line 66 – col. 6, line 25; col. 9, lines 6-17; col. 10, lines 9-38; col. 11, lines 49-67; col. 12, line 51 – col. 13, line 56; col. 14, lines 3-67).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Tracy's teachings of the tracking a user's shopping history (*Tracy, col. 9, lines 6-17*). with the teachings of Hudetz-Call, for the purpose of *identifying the existence of coupons or discount system or rebate applicable to a scanned product (Tracy, col. 12, line 51 – col. 13, line 56; col. 14, lines 3-67).*

Tracy discloses receiving at the user location (*user's portable terminal 100*) from the intermediate node (*the central host 150*) on the network the routing information and associated instructional code that instructs the user node to connect to the at least one desired location on the network (*the scanned product related items from other manufacturers*) (*Tracy, col. 12, line 51 – col. 13, line 56; col. 14, lines 3-67*); and

Tracy discloses connecting the user location to the desired location in accordance with the received instructional code such that connection to the desired location is connected by the intermediate code through the instructional code, wherein all connections to desired locations are controlled only by the intermediate node and not by any actions at the user location other than operation of reading, and wherein actions at the user location do not prevent connection or affect connection to the desired location (*Tracy*, col. 2, lines 12-62; col. 5, line 66 – col. 6, line 25; col. 9, lines 6-17; col. 10, lines 9-38; col. 11, lines 49-67; col. 12, line 51 – col. 13, line 56; col. 14, lines 3-67).

13. As to claim 2, Hudetz-Call-Tracy discloses the product code comprises a UPC (*Hudetz, Abstract*, col. 6, lines 7-45; *Call, Abstract*).

14. As to claim 3, Hudetz-Call-Tracy discloses the product code comprises an ISBN (*Hudetz, Abstract*, col. 6, lines 7-45; *Call*, col. 7, lines 49-61).

15. As to claim 4, Hudetz-Call-Tracy discloses the product code comprises an EAN (*Hudetz, Abstract*, col. 6, lines 7-45; *Call*, col. 3, lines 1-7).

16. As to claim 5, Hudetz-Call-Tracy discloses the routing information comprises a universal resource locator (URL) that comprises a unique locator on the network to the at least one desired location (*Hudetz*, col. 5, lines 55-67; col. 6, lines 1-6; *Tracy*, col. 2, lines 5-56).

17. As to claim 6, Hudetz-Call-Tracy discloses wherein the step of converting comprises:

providing the database (*Call, Fig. 2; Tracy, Fig. 6, central host 150*) having stored therein an associative table which relates a plurality of product code information with

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associated desired locations on the network, each of the product code information having routing information to that associated desired location associated therewith (*Tracy*, col. 2, lines 12-62; col. 5, line 66 – col. 6, line 25; col. 9, lines 6-17; col. 10, lines 9-38; col. 11, lines 49-67; col. 12, line 51 – col. 13, line 56; col. 14, lines 3-67); and

comparing the extracted product code information with the associative table in the database to determine the routing information to the at least one desired location (*Tracy*, col. 2, lines 12-62; col. 5, line 66 – col. 6, line 25; col. 9, lines 6-17; col. 10, lines 9-38; col. 11, lines 49-67; col. 12, line 51 – col. 13, line 56; col. 14, lines 3-67).

18. As to claim 8, Hudetz-Call-Tracy discloses the step of reading comprises scanning of the machine-readable code (*Hudetz*, Fig. 8, item 236) with a bar code scanner (*Hudetz*, Fig. 8, item 220) and wherein the machine-readable code comprises a bar code (*Hudetz*, Fig. 8, item 236).

19. As to claim 9, Hudetz-Call-Tracy discloses, decoding the machine-readable code to extract the product code information therefrom (*Hudetz*, col. 9, line 55 - col. 12, line 23).

20. As to claim 10, Hudetz-Call-Tracy discloses, wherein the machine readable product code comprises a bar code having the product code information encoded therein in a plurality of lines of varying width, each associated with machine readable codes; said the step of decoding is operable to extract the machine readable code from the lines during the step of reading, which step of reading comprises scanning the bar code with an optical bar code scanner (*Hudetz*, col. 9, line 55 - col. 12, line 23; *Tracy*, Fig. 4, item 100).

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21. As to claim 11, Hudetz-Call-Tracy discloses; wherein the step of assembling the message packet comprises forming a data transmission that is comprised of a first field having associated therewith source information as to the location on the network of the user location, as second field having associated therewith destination information as to the location of the intermediate node on the network and a third and data field having associated therewith the product code information (*Call, col. 8, line 66 – col. 9, line 19*).

22. Claim 12 is similar limitations of claim 1; therefore, it is rejected under the same rationale as in claim 1.

23. Claim 13 is similar limitations of claim 1; therefore, it is rejected under the same rationale as in claim 1

24. Claim 14 is similar limitations of claim 11; therefore, it is rejected under the same rationale as in claim 11

25. Claims 15-17 are similar limitations of claims 8-10; therefore, they are rejected under the same rationale as in claims 8-10.

26. Further references of interest are cited on Form PTO-892 which is an attachment to this office action.

Response to Arguments

27. Applicant's arguments and amendments filed on 16 November 2005 have been fully considered but they are not deemed fully persuasive.

28. In the remark, Applicant argued in substance that

Point (A), the prior art does not disclose wherein the intermediate node or server owns the URL link and not the creator of the unique code on page 12.

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As to point A, Tracy discloses the central host server in the shopping facility in Fig. 6 that, *"In the preferred embodiment, the system automatically creates a linked page for scanned items including any associated information matching a customer's preferences profile (col. 13, lines 12-37; col. 2, lines 12-56). Tracy suggests that, "alternatively, the "link" represents a data file stored at a remote source such as the manufacturer's web page, in which case the controller 150 sends the request over a wide area network and retrieves the data and routes the data to the portable terminal. The link may also include embedded passwords and data request commands required by the remote server for retrieval of the highlighted data field (col. 10, lines 9-38)".*

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen
Examiner
Art Unit 2142



HAO G VU
Primary Examiner

